REMARKS

Claims 1 – 25 were examined by the Examiner and were rejected. In response, Applicants are submitting the following remarks to further distinguish the present invention from the prior art of record. In view of the following remarks, Applicants respectfully request reconsideration of the application.

Applicants respectfully disagree with the Examiner choosing to use a layman's definition of the term "container." Applicants have explained the meaning of a marketing object container on, among other places, page 15 of the specification.

Rejection Under 35 U.S.C. § 112, First Paragraph

In Paragraph 6 of the final Office Action, Examiner rejected claims 1-21 and 23-24 under 35 U.S.C. § 112, first paragraph. Specifically, the Examiner stated that the specification failed to disclose the terminology "marketing location." Applicants respectfully disagree. The Examiner specifically cited page 15, lines 5-16 et seq. of the specification wherein the terminology is present. It reads, "[a] marketing object container, as referred to herein, includes a marketing location for receiving marketing objects to present to a user of an interactive medium, such as a networked device." Applicants not only use the terminology, but also specify the marketing object container as having a marketing location for receiving marketing objects. As such, Applicants believe they are in compliance with 35 U.S.C. § 112, first paragraph for claims 1-21 and 23-24 and request that this rejection be withdrawn.

Rejection Under 35 U.S.C. § 112, Second Paragraph

In Paragraph 8 of the final Office Action, Examiner rejected claims 1-21 and 23-24 under 35 U.S.C. § 112, second paragraph. Specifically, the Examiner claimed that Applicants have not described what a "marketing location" is intended to be in the specification. Applicants respectfully disagree. As mentioned above, the term "marketing location" is used in the specification on page 15 wherein it is explained as being a position in a marketing object container for receiving marketing objects. Therefore, Applicants believe they are in compliance with 35 U.S.C. § 112, second paragraph for claims 1-21 and 23-24 and request that the rejection be withdrawn.

Rejection Under 35 U.S.C. § 103

In paragraph 10 of the final Office Action, the Examiner rejected claims 1-2, 8-9, 12-15, 19 and 23-25 under 35 U.S.C. § 102(e) as being anticipated by Wong et al. (US Patent No. 5,890,175 B1); in the alternative, under 35 U.S.C. 103(a) as obvious over Wong et al. in view of the Screen-shot of JPG file attributes taken from WINDOWS NT (c) 1998 MICROSOFT Corp. (c) 1998 taken MAR 21.

As to claim 1, Applicants have amended claim 1 to overcome Examiner's rejection by adding the term "marketing" in front of the term "attribute." Support for this amendment is located throughout the specification. Applicants' amendment is by no means to narrow the scope of the claim because Applicants could argue that the claim should be allowable without amendment, but have decided to amend the claim for clarity. Applicants' argument is based on the usage and explanation of the term

marketing attribute in the specification. In this instance the term is not used as Examiner uses it in the rejection of the aforementioned claims. Examiner uses the well known definition of the term attribute (i.e. multimedia objects inherently have user defined attributes), whereas in the specification the term marketing attribute is used to describe, among other things, what objects can be received by the marketing object container, the relationship of a particular container to another, or timing and priority of the display of said objects. Wong et al. does not disclose or suggest associating a marketing attribute with the marketing object container. In addition, the combination of Wong et al. and the Screen-shot of JPG file attributes does not disclose or suggest this claimed limitation.

Applicants have repetitively explained and used the term marketing attributes in the specification and have amended claim 1 to clarify Applicants' meaning. Therefore Applicants believe that Wong et al. is not anticipatory of claim 1 and in the alternative claim 1 is not obvious over Wong et al. in view of the Screen-shot of JPG file attributes.

Referring to claims 2, 8-9, 12-15 and 19, claims 2, 8-9, 12-15 and 19 should be allowable for at least the same reasons as claim 1 because they are dependent on claim 1.

Referring to independent claims 23 and 24, claims 23 and 24 were amended in the same manner and for the same reasons as independent claim 1. Examiner states that claims 23 and 24 were rejected for identical reasons as independent claim 1. As such, amended claims 23 and 24 should be allowable for the same reasons as independent claim 1.

Referring to claim 25, claim 25 should be allowable for at least the same reasons as claim 24 because it is dependent on claim 24.

In paragraph 20 of the final Office Action, the Examiner rejected claims 3-7 under 35 U.S.C. § 102(e) as being anticipated by Wong et al. (noting the Screen-shot of JPG file attributes taken from WINDOWS NT (c) 1998 MICROSOFT Corp. (c) 1998 taken MAR 21 as evidence of Inherency of attributes in object); in the alternative, under 35 U.S.C. 103(a) as obvious over Wong et al. in view of Cragun et al. (U.S. Patent No. 6,162,112 B1).

Referring to dependent claims 3-7, claims 3-7 are dependent on independent claim 1. Therefore, claims 3-7 are not anticipatory on Wong et al. for the same reasons as independent claim 1 is not anticipatory on Wong et al. In addition, Applicants have amended claim 7 for the same reasons as the amendment of independent claim 1.

Cragun et al. discloses a web page presentation control mechanism and method allowing a user to set presentation attributes for one or more presentation items on a web page. In Cragun et al., a user may allow size change, allow motion, show detail, enter times for an active time, visible time and sleep time of a presentation item. Cragun et al. still fails to teach the claimed limitation of "associating a marketing attribute with the marketing object container." As such, the combination of Wong et al. and Cragun et al. does not disclose the claimed invention and therefore, claims 3-7 should be allowable. In addition, claims 3-7 should be allowable for at least the same reasons as independent claim 1 because claims 3-7 depend on independent claim 1.

In paragraph 25 of the final Office Action, the Examiner rejected claims 10-11, 20 under 35 U.S.C. 103(a) as obvious over Wong et al. in view of Henson (U.S. Patent No. 6,167,383 B1).

Henson discloses a method and apparatus for providing customer configured machines at an Internet site. In Henson, space for the display of customer-specific merchandising messaging as to up-sell and cross-sell opportunities are made available in the shopping cart. Assuming, arguendo, that Examiner's statement is true and that Henson "demonstrates dynamically associating a banner object wherein an up-sell or cross-sell feature was associated with the object," this still does not disclose the limitation of associating a marketing attribute with the marketing object container as disclosed in the limitations of independent claim 1 that claims 10-11 and 20 depend therefrom. In addition, for the reasons discussed above, the combination of Wong et al. and Henson does not disclose the claimed invention and therefore, claims 10-11 and 20 should be allowable. Further, claims 10-11, 20 depend on independent claim 1 and therefore should be allowable for at least the same reasons as independent claim 1.

In paragraph 28 of the final Office Action, the Examiner rejected claims 16-18 under 35 U.S.C. § 102(e) as being anticipated by Wong et al. (noting the Screen-shot of JPG file attributes taken from WINDOWS NT (c) 1998 MICROSOFT Corp. (c) 1998 taken MAR 21 as evidence of Inherency of attributes in object); in the alternative, under 35 U.S.C. 103(a) as obvious over Wong et al. in view of Kurtzmann II et al. (U.S. Patent No. 6,144,944 B1).

Referring to dependent claims 16-18, claims 16-18 are dependent on independent claim 1. Therefore, claims 16-18 are not anticipatory on Wong et al. for the same reasons as independent claim 1 is not anticipatory on Wong et al. In addition, Applicants have amended claim 16 for the same reasons as the amendment of independent claim 1.

Kurtzmann II et al. discloses a computer system for efficiently selecting and providing information wherein an advertisement server can provide selected advertisements in response to a request from a web page server. Examiner states that Kurtzmann II demonstrates that it was well-known to associate an "affinity attribute" with an object container. Applicants respectfully disagree with Examiner's above-mentioned statement. As in many of the other references that Examiner cites, Kurtzmann II's attributes are associated with marketing objects, *not* marketing object containers. Also, as in the other references, the attributes in Kurtzmann II, similar to the attributes that Examiner references, are not the same as the marketing attributes as defined in the specification of the present invention. Kurtzman II does not disclose or suggest associating a marketing attribute with a marketing object container and therefore claims 16-18 should be allowable over the prior art. Further, regarding claims 16-18, claims 16-18 depend from independent claim 1 and therefore should be allowable for at least the same reasons as independent claim 1.

In paragraph 32 of the final Office Action, the Examiner rejected claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Cragun et al. in view of Kiyono (U.S. Patent No. 6,137,483).

As noted above, <u>Cragun et al.</u> discloses a web page presentation control mechanism and method allowing a user to set presentation attributes for one or more presentation items on a web page. <u>Cragun et al.</u> still fails to teach the claimed limitation of "associating a marketing attribute with the marketing object container." Instead, in <u>Cragun et al.</u>, a user may allow size change, allow motion, show detail, enter times for an active time, visible time and sleep time of a presentation item. This in no way relates to the marketing object container, only to the presentation item that may be included in a marketing object container. <u>Kiyono</u> neither discloses or suggests the limitation of associating a marketing attribute with the marketing object container. Therefore, the combination of <u>Cragun et al.</u> and <u>Kiyono</u> does not disclose or suggest the claimed limitations in independent claim 21.

In paragraph 34 of the final Office Action, the Examiner rejected claim 22 under 35 U.S.C. § 103(a) as being unpatentable over <u>Collins-Rector et al.</u> (U.S. Patent No. 6,188,398) in view of <u>Ruttenberg et al.</u> (WO 99/62013).

<u>Collins-Rector et al.</u> discloses a method for enabling an interactive video experience utilizing the Internet in which entertainment is combined with advertising to create an enhanced advertising experience. In <u>Collins-Rector et al.</u>, an html page is created that contains at least three different frames. One frame contains a video clip to be displayed, a second frame contains an ad that is synchronized with the video and a third frame contains an ad toolbar.

<u>Ruttenberg et al.</u> discloses an advertising method through the internet that includes providing a multitude of campaign banners associated with sellers. Each

{00061122v1}10

banner is associated with a campaign budget related information and banner terms. In Ruttenberg et al., a campaign represents an ad for a product or service from one party (seller). Each campaign banner is associated with campaign banner terms. Campaign banner terms, as defined by Ruttenberg et al., include the costs associated with a party's (seller's) advertisement or campaign banner, such as the cost per customer click or cost per customer purchase of the party's product or service.

Independent claim 22 recites displaying a number of campaigns that are available to associate with the marketing object container. These campaigns are not analogous to the campaigns that Examiner cites in Collins-Rector et al. and Ruttenberg et al. The campaigns in Collins-Rector et al. and Ruttenberg et al. are object advertisements. Conversely, in independent claim 22, campaigns refer to types or features of advertisements (e.g. cross sells, daily promotions, holiday promotions, monthly promotions, up sells and the like, see p 16, line 8 - p 17, line 22). Applicants respectfully submit that Applicants' usage of campaign(s) differs so greatly from Collins-Rector et al. and Ruttenberg et al. that Examiner's rejection is improper.

Furthermore, Examiner states that Collins-Rector et al. discloses displaying a marketing object container on a display medium, in response to a selection of the marketing object container creating a campaign associated with the object container. Applicants respectfully disagree. Collins-Rector et al. does not display a number of campaigns that are available to associate with the marketing object container in response to a selection of the marketing object container. Collins-Rector et al. discloses a marketing object container wherein a marketing object can be displayed at

predetermined times while watching a video. Although Collins-Rector et al. associates

an advertisement of a product or service with the marketing object container, there is no

displaying of a number of campaigns in response to a selection of a marketing object

container. The display of an advertisement for a product or service in Collins-Rector et

al. does not depend on, nor is in response to, the selection of the marketing object

container. Additionally, Ruttenberg et al. does not disclose or suggest displaying a

number of campaigns, in response to a selection of the marketing object container, that

are available to associate with the marketing object container.

Examiner states that one cannot show nonobviousness by attacking references

individually when the rejections are based on combinations of references. However,

Applicants have submitted arguments based on the combination of these references. In

order for the rejection to be proper, all of the elements of the rejected claim must appear

within the cited references, and there must be a teaching or suggestion to combine or

modify these references. However, all of the elements of independent claim 22 do not

appear in the cited references, Collins-Rector et al. and Ruttenberg et al. Specifically,

these references, neither singly nor in combination, make any mention of a display of a

number of campaigns, in response to a selection of the marketing object container, that

are available to associate with a marketing object container.

In addition, if one were to combine the marketing object container in Collins-

Rector et al. with the container in Ruttenberg et al., the limitations in independent claim

22 are still not disclosed. Specifically, as discussed above, "the number of campaigns

that are available to associate with the marketing object container" in independent

claim 22 that is "in response to a selection of the marketing object container" is not

taught or suggested by Rutterberg et al. or Collins-Rector et al. Furthermore,

Applicants are unaware of any teaching or suggestion in the cited art to combine or

modify Ruttenberg et al. or Collins-Rector et al. to include these elements. Therefore,

Applicants submit that the rejection has been overcome by attacking the combination of

references and not by arguing the references singly. For all of these above-mentioned

reasons, independent claim 22 should be allowable.

Based on the foregoing remarks, Applicant believes that the rejections in the final

Office Action of October 10, 2001 are fully overcome and that the application is in

condition for allowance. If the Examiner has any questions regarding the case, the

Examiner is invited to contact Applicant's undersigned representative at the number

given below.

Respectfully submitted,

Chun R. Xia, et al.

Date:_____ᵞ|ɪₒ|ₒᵌ_____   By:_____

Matthew J. Cohen, Reg. No. 42,426
Carr & Ferrell LLP
2225 East Bayshore Road, Suite 200
Palo Alto, CA 94303
Phone: (650) 812-3495
Fax: (650) 812-3444

{00061122v1} 13

MARKED UP CHANGES

1. (Twice Amended) A method of providing an electronic marketing presentation, comprising:

displaying a marketing object container, said marketing object container including a marketing location for receiving at least one marketing object to be presented in said marketing container to a user of an interactive medium;

associating a[n] <u>marketing</u> attribute with the marketing object container; and

selecting at least one marketing object for being associated with the marketing object container.

7. (Amended) The method of claim 1, further comprising associating an item with the <u>marketing</u> attribute.

14. (Amended) The method of claim 1, wherein the marketing object container is dynamically associated with the <u>marketing</u> attribute.

16. (Amended) The method of claim 1, wherein a plurality of marketing objects are selected to be associated with the marketing object container, and wherein the <u>marketing</u> attribute determines which of the selected marketing objects is associated with the marketing object container at a particular time.

23.   (Twice Amended)   A system of providing an electronic marketing presentation, comprising:

a processor configured to display a marketing object container, said marketing object container including a marketing location for receiving at least one marketing object to be presented by means of said marketing container to a user of an interactive medium; the processor also being configured to facilitate associating a[n] marketing attribute with the marketing object container; and selecting at least one marketing object for being associated with the marketing object container; and

a memory coupled with the processor, the memory being configured to provide the processor with instructions.

24.   (Twice Amended)   A computer program product for providing an electronic marketing presentation, comprising:

computer code displaying a marketing object container, said marketing object container including a marketing location for receiving at least one marketing object to be presented by means of said marketing container to a user of an interactive medium;

computer code associating a[n] marketing attribute with the marketing object container; and

a computer readable medium that stores the computer codes.